

Filed by

Fred E. McKelvey
Senior Administrative Patent Judge
Mail Stop Interference
P.O. Box 1450
Alexandria Va 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Filed 17 January 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge McKelvey)

ROBERT H. GRUBBS and MATTHIAS SCHOLL,

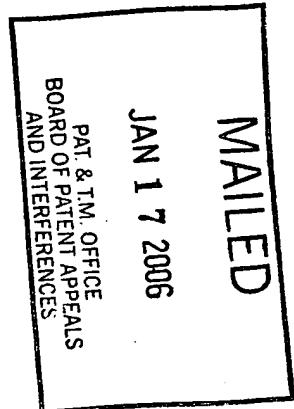
Junior Party
(Application 09/576,370),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party
(Application 09/392,869).

Patent Interference No. 105,373
Technology Center 1600



REDECLARATION - Bd.R. 203(c)

A. Introduction

1. In the ORDER SETTING TIMES FOR TAKING ACTION-- MOTIONS PHASE (Paper 29, Part B(5)), it was indicated that a formal order redeclaring the interference would be entered during the first week in January of 2006.

2. This REDECLARATION is intended to be that formal order.

B. Order

Substitution of Count 2 for Count 1

1. The parties have agreed that Count 2 should be substituted for Count 1 (Paper 1, pages 6-7); the board concurs (Paper 29, page 2, ¶ B(1)).

2. Count 2, which is set out in Appendix 1 of this REDECLARATION is substituted for Count 1 (Paper 1, page 6-7).

Claim correspondence

3. In a MEMORANDUM OPINION and ORDER -- Bd.R. 104(a) (Paper 3), the board (1) invited Nolan to correct Fig. 4 of its drawings and (2) required Nolan to submit a new set of claims.

4. Because the parties have agreed on a count which the board finds suitable, there is no need for Nolan to file an amendment (Paper 29, pages 2-3, ¶¶ 6-9).

5. Accordingly, any amendments of the claims submitted by the parties need not be entered.

6. Instead, the interference can be resolved on the basis of the Grubbs and Nolan claims presently in the respective applications involved in the interference.

7. The claims of the parties are:

Grubbs: 1-64

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and
77-111

8. The claims of the parties which correspond to
Count 2 are:

Grubbs: 1-39 and 41-64

Nolan: 9, 11-14, 17-21, 23-40, 45-46, 51-62,
71, 73, 77-78, 89-92 and 107-109

9. The claims of the parties which do not correspond
to Count 2 are:

Grubbs: 40

Nolan: 43-44, 47-50, 63-65, 72, 79-88, 93-106
and 110-111

Priority benefit as to Count 2

10. Consistent with discussion during a conference
call (Paper 29, page 2, ¶ B(4)), the benefit accorded in
DECLARATION (Paper 1, pages 3 and 4) is accorded as to Count 2.

11. As to Count 2, Grubbs is accorded benefit for the
purpose of priority of:

Provisional application 60/142,853,
filed 07 July 1999

12. As to Count 2, Nolan is accorded benefit for the
purpose of priority of:

Provisional application 60/115,358,
filed 08 January 1999

Nolan request to amend its drawing

13. Nolan has filed an amendment to correct Fig. 4 of its drawings.

14. The amendment to correct the Fig. 4 of the drawing is found appropriate.

15. Entry of the amendment to correct Fig. 4 of the Nolan drawings is authorized.

/ss/Fred E. McKelvey
FRED E. McKELVEY,
Senior Administrative Patent Judge¹

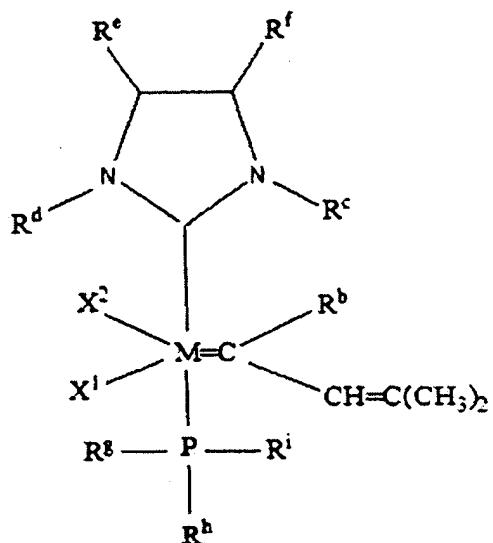
17 January 2006
Alexandria, VA

¹ As part of board efforts under the government Paperwork Elimination Act, signatures on papers originating from the board have been phased out in favor of a completely electronic record. Consequently, in this case papers originating at the board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 CFR § 10.18.

Appendix 1

Count 2

A composition of matter having the formula:



where:

M is Ru or Os;

X¹ and X² are each independently an anionic ligand;

P is phosphorus

R^g, R^h and Rⁱ are each independently

- (1) a C₁₋₁₀ alkyl group,
- (2) a C₃₋₁₀ cycloalkyl group or
- (3) a C₅₋₂₀ aryl group;

R^b, R^c, R^d, R^e and R^f are each independently

- (1) hydrogen,
- (2) a C₁₋₂₀ alkyl group,
- (3) a C₂₋₂₀ alkenyl group,
- (4) a C₂₋₂₀ alkynyl group,
- (5) an aryl group,
- (6) a C₁₋₂₀ carboxylate group,
- (7) a C₁₋₂₀ alkoxy group,
- (8) a C₂₋₂₀ alkenyloxy group,
- (9) a C₂₋₂₀ alkynyloxy group,
- (10) an aryloxy group,
- (11) a C₂₋₂₀ alkoxy carbonyl group,
- (12) a C₁₋₂₀ alkylthiol group,
- (13) a C₁₋₂₀ alkylsulfonyl group or
- (14) a C₁₋₂₀ alkylsulfinyl group,

where each of R^b, R^c, R^d, R^e and R^f is optionally substituted with

- (a) halogen,
- (b) a C₁₋₁₀ alkyl group,
- (c) a C₁₋₁₀ alkoxy group,
- (d) an aryl group,
- (e) a hydroxyl group,
- (f) a thiol group,
- (g) a thioether group,
- (h) a ketone group,
- (i) an aldehyde group,
- (j) an ester group,

- (k) an ether group,
- (l) an amino group,
- (m) an amido group,
- (n) an imino group,
- (o) a nitro group,
- (p) a carboxylic acid group,
- (q) a disulfide group,
- (r) a carbonate group,
- (s) an isocyanate group,
- (t) a carbodiimide group,
- (u) a carboalkoxy group or
- (v) a carbamate group.

105,373
cc (via electronic mail):

Attorney for Grubbs
(real party in interest
California Institute of Technology):

Lisa A. Haile, Esq.
Antony M. Novom, Esq.
Email: lisa.haile@dlapiper.com
Email: antony.novom@dlapiper.com

Attorney for Nolan
(real party in interest
University of New Orleans Foundation):

R. Andrew Patty II, Esq.
Mary H. Drabnis, Esq.
Email: rap@patentcounsel.com
Email: mhd@patentcounsel.com